

## **REMARKS**

The Office Action dated June 6, 2005, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 1-17, 23-41, 47-53 are currently pending in the present application.

### **Claims**

Claims 1-2, 4-12, 17, 23, 25-26, 28-36, 41 and 47-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by Handelman et al. (U.S. Patent No. 6,298,441, hereinafter "Handelman"). The Applicants respectfully traverse the rejection, as follows.

Claim 1 and claim 10 recite a method for restricting access to electronic books displayed on a viewer comprising, among other features, displaying an identification or title of an electronic book on a viewer.

Claim 25 and claim 34 recite an apparatus for restricting access to electronic books displayed on a viewer comprising, among other features, a display that displays an identification or title of an electronic book on a viewer.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicants' invention.

In making the rejection, the Office Action characterized Handelman as allegedly disclosing "displaying an identification of an electronic book on a viewer," and refers to "screen 425 in Figure 12" of Handelman.

Applicants submit that Handelman provides a "document presentation apparatus such as display screen 425 and speakers 430. It is appreciated that, in Figure 12, the display screen 425 and the speakers 430 are shown only as an example of document presentation apparatus and that any appropriate apparatus for making the document

405 palpable to the senses may be alternatively or additionally used.” Col. 16, lines 5-56.

Applicants submit that Handelman fails to disclose or suggest each and every element recited in claims 1, 10, 25 and 34 of the present application. In particular, it is submitted that the display screen 425 of Handelman is neither comparable nor analogous to the feature of “displaying an identification or title of an electronic book on a viewer,” or “a display that displays an identification or title of an electronic book on a viewer.” In fact, the display screen 425 of Handelman is merely a screen with no relationship with the above-discussed feature of claims 1, 10, 25 and 34. The Applicants submit that although Handelman provides a display screen 425, Handelman nevertheless fails to show at least “a display that displays” or “displaying an identification or title of an electronic book on a viewer,” as claimed. Therefore, the Applicants submit that claims 1, 10, 25 and 34 are allowable over Handelman.

Moreover, to qualify as prior art under 35 U.S.C. §102, a single prior art reference must teach, i.e., identically describe, each feature of a rejected claim. As explained above, Handelman fails to disclose or suggest each and every feature of claims 1, 10, 25 and 34. Accordingly, the Applicants respectfully submit that claims 1, 10, 25 and 34 are not anticipated by the disclosure of Handelman. Therefore, the Applicants respectfully submit that claims 1, 10, 25 and 34 are allowable at least for this reason.

As claims 2 and 4-9 depend from claim 1, claim 11 depends from claim 10, claims 26 and 28-33 depend from claim 25, and claim 35 depends from claim 34, the Applicants submit that each of these claims incorporates the patentable aspects therein,

and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

As for the rejection of claims 12, 17 and 36, the Office Action referred to the rejection of claims 1-2, respectively. The Applicants respectfully traverse this rejection for similar reasons to those with regard to claims 1, 10, 25 and 34.

In particular, claim 12 and claim 17 recite a method for permitting a user to restrict access to a plurality of stored electronic books for display on a viewer comprising, among other features, permitting a particular user to assign a rating to each of the electronic books, the ratings being related to content of the electronic books.

Claim 36 recites an apparatus for permitting a user to restrict access to a plurality of stored electronic books for display on a viewer comprising, among other features, a permitting module that permits a particular user to assign a rating to each of the electronic books, the ratings being related to content of the electronic books.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicants' invention. For instance, the Office Action cited column 14, lines 38-42 of Handelman, which states that "the CA document loading unit 350 might be checked; for example, a particular parental control rating might be required of the CA document loading unit 350 in order to operate with the information storage smart card 385."

The Applicants submit that the referenced section neither teaches nor discloses at least the feature of "a permitting module" or "permitting a particular user to assign a rating to each of the electronic books, the ratings being related to content of the electronic books."

Handelman in the text merely refers to a parental control rating, but fails to disclose at least the feature of permitting a user to assign a rating to each electronic book, as claimed.

The Applicants therefore submit that claims 12, 17 and 36 are allowable over the cited art.

As for the rejection of claim 23, the Office Action referred to the rejection of claim 1. The Applicants respectfully traverse.

Claim 23 recites a method for controlling access to an electronic book displayed on a viewer comprising, among other features, receiving information relating to a viewer mode for displaying the electronic book on the viewer.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicants' invention because Handelman fails to teach at least the feature of receiving information relating to viewer mode. For at least this reason, the Applicants submit that claim 23 is allowable over the cited art.

As for the rejection of claim 41, the Office Action referred to the rejection of claim 17, which in turn referred to the rejection of claims 1 and 6.

Claim 41 recites an apparatus for permitting a user to restrict access to a stored electronic book for display on a viewer comprising, among other features, a permitting module that permits a particular user to select portions of the electronic book for use in restricting access to a content of the electronic book.

The Office Action referred to column 17, lines 27-32 of Handelman, which states that "conditional access information stored in the information smart card 385 comprises

parental control information, controlling which portions or which version of all or portion of the document may be displayed.”

It is submitted that the referenced section is neither comparable nor analogous to the features recited in claim 41. For example, this text of Handelman fails to provide a permitting module that permits a particular user to select portions of the electronic book for use in restricting access to a content of the electronic book, as claimed. Rather, this text of Handelman merely provides a predetermined set documents, for which a user cannot select portions of the documents for display. In other words, Handelman fails to provide the user any option or choice to modified the document for selecting the portion the user wants to access. Therefore, Applicants submit that Handelman fails to disclose each and every element recited in claim 41 of the present application and is allowable at least for this reason.

As for rejection of claim 47, the Office Action characterized Handelman as disclosing the recited features and cites column 17, lines 3-6, and refers to “authorization module 420 in Figure 12 and column 17, lines 6-11.”

The Applicants respectfully traverse.

The cited portions of Handelman provide that,

[T]he document utilization module 415, typically under command of a user of the document access unit 410, is typically operative to read and decrypt a document stored in the information smart card 385. The reading and decrypting of the document preferably takes place under conditional access control, as described above, in which the authorization module 420 applies any applicable conditional access control, typically based upon parameters stored in the information smart card 385, as described above.

Claim 47 recites an apparatus for controlling access to an electronic book displayed on a viewer comprising, among other features, a receiving module that receives information relating to viewer mode for displaying the electronic book on the viewer; and restricting module that restricts access to a content of the electronic book based upon the viewer mode.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned combination of features of the Applicants' invention, as claimed in claim 47.

In particular, it is submitted that the card 385 and the authorization module 420 of Handelman are neither comparable nor analogous to the receiving module and restricting module, respectively of the present invention.

Furthermore, the Applicants respectfully disagree with the Office Action's position in stating that the "viewing mode [the] is the document to be displayed." According to one example of the present invention, the viewing mode provides a user with a particular viewing option for displaying the electronic book on the viewer. Based on the viewing mode, the restricting module restricts access to content of the electronic book based upon the viewer mode.

In contrast, if the viewing mode is the document to be displayed, as apparently assumed by the Office Action, then the document is presumed to be always displayed, and therefore Handelman does not further restrict access to content of the electronic book based on the viewer mode. Therefore, the Applicants submit that Handelman fails to disclose each and every element recited in claim 47 of the present application and is allowable over this reference.

As claim 48 depends from claim 47, the Applicants submit that claim 48 incorporates the patentable aspects therein, and is therefore allowable for at least the reasons set forth above with respect to the independent claim, as well as for the additional subject matter recited therein.

Accordingly, the Applicants respectfully request withdrawal of the rejection.

**Claims 3, 13-16, 24, 27, 37-40 and 49-53**

Claims 3, 13-16, 24, 27, 37-40 and 49-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Handelman in view of Block et al. (U.S. Patent No. 6,675,384, hereinafter "Block"). The Applicants respectfully traverse the rejection, as follows.

Handelman is discussed above.

Block is applied for allegedly curing the deficient features recited in claims 3, 13-16, 24, 27, 37-40 and 49-53.

As claim 3 depends from claim 1, claim 13 depends from claim 12, claim 24 depends from claim 23, claim 27 depends from claim 25, and claims 37-40 depend from claim 36, the Applicants submit that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

As for the rejection of claims 50-53, claim 50 recites a method for electronically displaying a page of an electronic book on a viewer and permitting a user to restrict content of the electronic book comprising, among other features, permitting a user to identify at least a portion of the content displayed within the screen; and displaying a

section within the screen for permitting the user to request restriction of the identified content.

Claim 51 recites a screen for use in electronically displaying a page of an electronic book on a viewer and permitting a user to restrict content of the electronic book comprising, among other features, a section within the screen for displaying a page of an electronic book, the page including at least a portion of content of the electronic book and a section permitting a user to identify at least a portion of the content displayed within the screen; and a restrict section within the screen for permitting the user to request restriction of the identified content.

Claim 52 recites a method for electronically displaying a screen on a viewer for receiving access levels and a view mode relating to display of electronic books on the viewer comprising, among other features, displaying a viewer mode section within the screen for receiving entry of a viewer mode, the viewer mode being used for determining a type of information used to restrict access to the electronic books.

Claim 53 recites a screen for use in electronically displaying a screen on a viewer for receiving access levels and a view mode relating to display of electronic books on the viewer comprising, among other features, a view mode section within the screen for receiving entry of a viewer mode, the viewer mode being used for determining a type of information used to restrict access to the electronic books.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned combination of features of the Applicants' invention, as recited in these claims.



In making the rejection with respect to claims 50 and 51, the Office Action referred to "the rejection of claim 3 and also note the rejection of claims 1 and 4 where Handelman discloses the additional limitations. ...Block discloses a labeling editor for assigning the ratings to the electronic books for restricting content and Handelman discloses the system for using a smart card to load and restrict access to electronic books."

In making the rejection of claims 52-53, the Office action referred to the rejection of claims 13 and 48.

As a preliminary matter, the Applicants respectfully traverse since claims 50-53 recite various different features and subject matter as that of claims 1, 3, 4, 13 and 48. Therefore, the Applicants respectfully submit that the basis for rejection of claims 1, 3, 4, 13 and 48 has been erroneously applied to the rejection of claims 50-53.

In addition, Applicants submit that the combination of Handelman in view of Block fail to disclose or suggest each and every element recited in claims 50-53 of the present application.

To establish *prima facie* obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and In re Royka, 490 F.2d 981 (CCPA 1974). As explained above, Handelman in view of Block, alone or in combination, do not teach or suggest each feature recited by claim 50-53. Accordingly, for the above provided reasons, Applicants respectfully submit that claims 50-53 are not rendered obvious under 35 U.S.C. § 103 by the teachings of Handelman in view of Block, and are allowable.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

The Applicants respectfully request withdrawal of the rejection.

### **Conclusion**

In view of the above, the Applicant respectfully requests allowance of claims 1-17, 23-41, 47-53 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Docket No. 026880-00000 (5264).

Respectfully submitted,



Juliana Haydoutova  
Attorney for Applicants  
Registration No. 43,313

**Customer No. 004372**  
ARENT FOX PLLC  
1050 Connecticut Avenue, N.W., Suite 400  
Washington, D.C. 20036-5339  
Tel: (202) 857-6000  
Fax: (202) 638-4810

JH:ksm

Enclosure: Petition for Extension of Time (2 months)